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July 13, 2006

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2627 - Examiner Klimowicz, William Joseph

FROM: Stephen B. Ackerman, Reg. No. 37,761
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/796,387
File Date: 03/09/2004
Inventor: Cheng T. Horng
Examiner: Klimowicz, William Joseph
Art Unit: 2627
Title: A Novel Process and Structure to Fabricate CPP Spin Valve Heads for Ultra-High Recording Density

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated June 13, 2006. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on July 13, 2006.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: July 13, 2006

35 U.S.C. 121:

The inventions stated are:

I - Claims 34-55, drawn to a CPP spin valve structure, classified in class 360, subclass 324.1, and

II - Claims 1-33, drawn to a method of fabricating a CPP spin valve structure, classified in class 204, subclass 192.2.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group II - Claims 1-33, drawn to a process classified in Class 204, subclass 192.2. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of

"fabricating a CPP spin valve structure", and that the product claims are directed to "a CPP spin valve structure", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 204/192.2 and product class/subclass 360/324.1, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case the product could be made by a process not requiring the fabrication steps as articulated in the method claims, including the use of, *inter alia*, a chemical etch, a particular pressure of oxygen not specifically set forth in identifying Group I, etc." is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the cost of additional patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Applicant was further required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

The species stated are:

Specie I: Figure 1, which reads on Claims 1-17, and

Specie II: Figure 2, which reads on Claims 18-33.

Applicant provisionally elects to be examined the species described by the Examiner as Specie I , which reads on Claims 1-17. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Election of Species given in the Office Action, because of the increased costs applicant would be forced to bear if the two species are separately examined. Furthermore, the field of search must necessarily cover both species, in addition to other related Classes and subclasses, to provide a complete and adequate search.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,



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